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10/589,313

06/16/2009

Renaud Moliton

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11/09/2010

SOFER & HAROUN LLP.

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NEW YORK, NY 10017

EXAMINER

SCHWARTZ, JORDAN MARC

ART UNIT

PAPER NUMBER

2873

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/589,313 | Applicant(s) MOLITON ET AL. | |
| | Examiner Jordan M. Schwartz | Art Unit 2873 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>8/10/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because it incorrectly states that priority has not been claimed for foreign application Fr 0450294. This contradicts the first paragraph of the specification in which it is stated that priority has been claimed as to this foreign application. Presumably the declaration is in error. Correction is required.

Claim Rejections - 35 USC § 112

Claim 1 (and its dependent claims) is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an ophthalmic device for forming an ophthalmic display, said ophthalmic device comprising: an ophthalmic lens, an optical imager... (the assumed meaning for purposes of examination), does not reasonably provide enablement for an “ophthalmic lens for forming an ophthalmic display, said ophthalmic lens comprising an optical imager...”. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

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Specifically, throughout the specification and figures, applicant discloses an ophthalmic device such as figs 1, 4, 5 (the ophthalmic lenses and imager combined as the device) comprising ophthalmic lenses (such as figs 1, 4, 5, lenses "10" and "11") and an optical imager (such as figs 1, 4, and 5, optical imager "5") but does not disclose the ophthalmic lens itself (such as lens "10") comprising an optical imager ("imager "5"). In all of the embodiments, the imager is secured to the lens and is not comprised by the lens. Additionally, applicant is claiming the imager secured to the lens ("said optical imager being secured to said lens") so therefore claiming that the lens comprises the imager is not consistent with what is claimed.

Claims 1 and 3-6 (and dependent claims 2 and 7-8) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 1 and 3-6, applicant is claiming the lens "being associated with markings" (in independent claim 1) but then claims such as in claims 3-6 that such "markings" includes information defining the center of the eye, the shape of the frame, the angle of the frame, a distance between the lens and the center of the eye, a direction of cosines, a value of the power compensation provided to the imager, which are not disclosed as markings on the lens rendering the claims vague and indefinite. Specifically, while the information as to the position of the far vision point is disclosed as an actual physical "marking" i.e. a marking on the lens, the other claimed information is actually not disclosed as a physical marking but is disclosed as information used in conjunction with the far vision point marking to orient the lens relative to the imager.

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Therefore, it is not clear as to what is meant by the claimed “in association with markings” rendering the claims vague and indefinite.

For purposes of examination, the assumed meaning of claim 1 is “the ophthalmic lens being associated with a marking and with additional information, said marking and said additional information for referencing the position of the imager relative to said ophthalmic lens as a function of the correction parameters of said ophthalmic lens”.

With respect to claim 3, the assumed meaning is “said marking comprises the position of the far vision point and said additional information is for defining said virtual...”.

With respect to claim 4, the assumed meaning is “wherein said additional information defining the virtual...”

With respect to claim 5, the assumed meaning is “wherein said additional information comprises the direction cosines...”

With respect to claim 6, the assumed meaning is “wherein said additional information includes a value for the power...”

Claim Objections

Claim 8 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Specifically, based upon the assumed meaning of the 112 first paragraph rejection above, claim 8 would not be further limiting.

Claims 1-8 are objected to because of the following informalities:

1. with respect to claims 1, 4-5, and 8, the claimed "the lens" or "said lens" should be corrected to "the ophthalmic lens" or "said ophthalmic lens" for clarity;

2. with respect to claims 2-8, the claimed "A lens according to claim..." should be corrected to An ophthalmic device according to claim... (based on the assumed meaning) to correct the preamble of these claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 01/06298 (WO'298).

WO'298 reads on these claims by disclosing the limitations therein including the following: an ophthalmic device for forming an ophthalmic display (abstract, page 20, line 12 to page 21, fig 15, the combined lens "1514" and imager "1515" as the "ophthalmic device" or fig 20, page 23, lines 3-23, again the combined ophthalmic lens and imager as the "ophthalmic device"); said ophthalmic device comprising an ophthalmic lens (fig 15, ophthalmic lens "1514" and fig 20, ophthalmic lens "2023"); an optical imager for shaping light beams directed towards the eye of the wearer to enable information content to be viewed (abstract, figs 15 and 20, page 20, line 12 to page 21,

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line 10, page 23, lines 3-23, the imager "1515" and "2022"); the optical imager being secured to the lens (figs 15 and 20, page 20, line 13, page 23, lines 3-23); the ophthalmic lens being associated with markings (figs 15 and 15.1, page 20, line 12 to page 21, line 10, page 23, lines 3-23, the astigmatic markings i.e. the ophthalmic lens "being associated with markings"); the ophthalmic lens being used in association with additional information (page 15, lines 19-24, the users angles of gaze and/or the interpupillary distance as the "additional information"); the marking and additional information for referencing the position of the imager relative to said ophthalmic lens as a function of the correction parameters of said ophthalmic lens (page 15, lines 19-24, page 20, line 12 to page 21, line 19, page 23, lines 3-20). With reference to claim 1, WO'298 discloses the device "being associated with markings and being associated with additional information" as set forth above. Regardless, applicant is not claiming that the device comprises such markings (and additional information) but that it is being associated with markings and additional information. Therefore, the claimed "being associated with markings and additional information...as a function of the correction parameters of said lens" is not adding any additional structure to the claimed device but is merely claiming the intended use of the device i.e. the device being used in association with markings and additional information as claimed. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

With respect to claims 2-6, applicant is not claiming the device or ophthalmic lens comprising markings or comprising the additional information but the device being associated with markings and additional information i.e. being associated with information as to the center of the eye, the shape angle of the frame etc and being associated with a marking as to the position of the far vision point, etc. As stated above, the claimed “being associated with markings and additional information...as a function of the correction parameters of said lens” is not adding any additional structure to the claimed device but is merely claiming the intended use of the device i.e. the device being used in association with the claimed markings and the claimed additional information. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

With respect to claim 7, WO'298 discloses securing means to enable the imager to be positioned in compliance with the position indicated by the mark (page 15, lines 19-24, page 20, line 12 to page 21, line 19, page 23, lines 3-20).

With respect to claim 8, WO'298 discloses positioning the imager relative to the lens as a function of correction parameters of the lens (page 15, lines 19-24, page 20, line 12 to page 21, line 19, page 23, lines 3-20).

Prior Art Citations

For applicant's information, since applicant is not claiming the device comprising a marking but rather claiming the device “associated with a marking” then numerous

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other references would have read on or made obvious a number of the above rejected claims based upon the "intended use" rejections set forth above.

Renard patent number 6,910,769 and Schindler et al patent number 6,945,648 are being cited herein to show ophthalmic devices that would have read on or made obvious a number of the above rejected claims, however, such rejections would have been repetitive.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is 571-272-2337. The examiner can normally be reached on Monday to Friday from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on 571-272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jordan M. Schwartz
Primary Examiner
Art Unit 2873
November 3, 2010

/Jordan M. Schwartz/
Primary Examiner, Art Unit 2873